

REMARKS

Claims 1-35 are pending in the present application. By this Response, claims 1, 4, 5, 9, 16, 17, 20, 21, 25 and 32-35 are amended. Claims 1, 17 and 33 are amended to recite "associating a second field with the electronic property, wherein the second field includes a list of owners having an order of transfer of rights to the electronic property between a plurality of previous owners and wherein access control software allows access to the electronic property only upon verification that a user satisfies specified requirements for access, and wherein the specified requirements includes the user being listed as the current owner in the first field." These features are supported at least on page 12, lines 13-15 and on page 13, lines 19-21 of the current specification.

Claims 1, 9, 16, 17, 25, 32 and 33 are amended to provide proper antecedent basis for the term "electronic property". Claims 4, 20 and 34 are amended to recite "adding an entry with information about the subsequent owner in the second field, wherein the information about the subsequent owner includes a time period of ownership for the subsequent owner." These features are supported at least on page 13, lines 14-18 and figures 4-5 of the current specification. Claims 5, 21 and 35 are amended to be consistent with amended claims 4, 20 and 34.

No new matter is added as a result of the above amendments. Reconsideration of the claims in view of the above amendments and the following Remarks is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph, Claims 1-35

The Office Action rejects claims 1-35 under 35 U.S.C. § 112, second paragraph, as being allegedly incomplete for omitting essential steps, such omission amounting to a gap between the steps. This rejection is respectfully traversed.

The Office Action states that an example of an omitted step included in the Applicants' disclosure and corresponding drawings is where seller digitally signs the time of ownership. Applicants respectfully submit that there is no requirement that the claims recite every feature of the invention but only those features that Applicants regard as the

invention. Applicants have done so in the originally presented claims and the claims are not incomplete. For example, the invention recited in claim 1 does not require a "time period of ownership" for one of ordinary skill in the art to discern what Applicants regard as the invention. The claims are not a cookbook for making the invention. In addition, claim 1, 17 and 33 are amended to include the feature of access control software allowing access to the electronic property only upon verification that a user satisfies specified requirements, which includes the user being listed as the current owner in the first field, for access. By adding this feature, claims 1, 17 and 33 now connect interrelated elements and are therefore complete.

Furthermore, claims 4, 20 and 34 are amended to recite "adding an entry with information about the subsequent owner in the second field, wherein the information about the subsequent owner includes a time period of ownership for the subsequent owner." Claims 5 and 21 are amended to recite the feature of "allowing access to the electronic property by the subsequent owner only after the current owner has electronically signed an entry identifying the subsequent owner in the second field." These two claims in combination describe the allegedly "essential steps" of digitally signing and the time period of ownership. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-35 under 35 U.S.C. § 112, second paragraph.

II. 35 U.S.C. § 102(b), Alleged Anticipation, Claims 1-35

The Office Action rejects claims 1-35 under 35 U.S.C. § 102(b) as being anticipated by Ginter et al. (U.S. Patent No. 5,910,987 A1). This rejection is respectfully traversed.

As to independent claim 1, the Office Action states:

As per the following claim, Ginter et al. discloses:

1. A method of augmenting digital rights management, the method comprising: associating a first field with an electronic document, wherein the first field identifies a current owner of the electronic document (column 144, line 12 - column 145, line 49); and associating a second field with the electronic document, wherein the second field contains information about previous ownership of the electronic document (figures 26a-b and associated text); and wherein access control software allows access to the property only upon verification that a user

satisfies specified requirements for access (columns 82-83; column 135, lines 20-34).

Office Action dated December 23, 2003, pages 2-3.

Amended independent claim 1, now recites:

1. A method of augmenting digital rights management, the method comprising:
 associating a first field with an electronic property, wherein the first field identifies a current owner of the electronic property; and
 associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners; and
 wherein access control software allows access to the electronic property only upon verification that a user satisfies specified requirements for access, wherein the specified requirements include the user being listed as the current owner in the first field. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Ginter does not teach every element of the claimed invention arranged as they are in claim 1. Specifically, Ginter does not teach associating a second field with the electronic property that includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners.

Ginter is directed to systems and methods for electronic commerce including secure rights protection to ensure that information is accessed and used only in authorized ways, and maintain the integrity, availability, and/or confidentiality of the information. Secure subsystems used with electronic appliances provide a distributed virtual distribution environment (VDE) that may enforce a secure chain of handling and control, for example, to control and/or meter or otherwise monitor use of electronically stored or

disseminated information. Such a virtual distribution environment may be used to protect rights of various participants in electronic commerce and other electronic or electronic-facilitated transactions. Secure distributed and other operating system environments and architectures, employing, for example, secure semiconductor processing arrangements that may establish secure, protected environments at each node. These techniques may be used to support an end-to-end electronic information distribution capability that may be used, for example, utilizing the "electronic highway"(Abstract).

Ginter does not teach associating a second field with an electronic property that includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners. The Office Action alleges that Ginter teaches these features in figures 26a-b and the associated text, which appears at column 159, line 13 to column 160, line 12. However, in this section, Ginter only teaches a permission record header, which is a part of a permission record for an embedded content object. The permission record header includes an original distributor ID field that specifies who originally distributed the permission record and/or corresponding object, and a last distributor ID field that specifies who the last distributor of the permission record and/or the object was. While Ginter teaches keeping records of who the original and the last distributor was using these two IDs, these two IDs do not provide a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners.

In the present invention, the second field, which is the owner history field, includes a list of owners having an order according the historical order of transfer of rights to the electronic property. For example, in Figure 4 of the current specification, the list of owners of digital document 401 includes owner 1 and owner 2. This means when owner 1 transfer rights of document 401 to owner 2, the owner history field is updated with owner 2 after owner 1, which shows a historical order of transfer of rights to the electronic property. Ginter does not teach such a feature. Ginter teaches in Figures 26a and 26b that only the last distributor is specified in the permission record header, there is no historical order of transfer of rights to the electronic property shown in the last distributor ID field. To the contrary, using Ginter's last distributor ID field, if a new distributor becomes the last distributor, the current distributor in the last distributor

field will be replaced with the new distributor. There is no chain of ownership or ownership history stored in the last distributor ID field.

Even if the original distributor ID field is to be combined with the last distributor ID field to form a list, the list would still not be a list of owners having an order according to historical order of transfer of rights to the electronic between a plurality of previous owners, because all the intermediate distributors between the original distributor and the last distributor within the history of transfers of rights would be lost. Only the last distributor is identified in the field. Thus, Ginter does not teach the features of claim 1.

In view of the above, Applicants respectfully submit that Ginter does not teach or suggest each and every feature of claim 1. The other independent claims 17 and 33 recite similar features also not taught by Ginter. Accordingly, Applicants respectfully request the withdrawal of independent claims 1, 17 and 33 under 35 U.S.C. § 102(b). At least by virtue of their dependency on independent claims 1, 17 and 33, Ginter does not teach or suggest each and every feature of dependent claims 2-16, 18-32 and 34-35. Therefore, Applicants respectfully request the withdrawal of claims 1-35 under 35 U.S.C. § 102(b).

In addition to the above, Ginter does not teach the specific features of dependent claims 2-16, 18-32 and 34-35. For example, with regard to dependent claim 3, which is representative of claim 19 with regard to similarly recited subject matter, Ginter does not teach notifying the electronic property's manufacturer in case of property rights violations. The Office Action alleges that Ginter teaches these features at column 42, lines 4-16, which reads as follows:

Support certificate processes that ensure authorized interoperability between various VDE installations so as to prevent VDE arrangements and/or installations that unacceptably deviate in specification protocols from other VDE arrangements and/or installations from interoperating in a manner that may introduce security (integrity and/or confidentiality of VDE secured information), process control, and/or software compatibility problems. Certification validates the identity of VDE installations and/or their components, as well as VDE users. Certification data can also serve as information that contributes to determining the decommissioning or other changes related to VDE sites.

In the above section, Ginter teaches that security of the VDE secured information is ensured for authorized access only by using certification, which validates the identity

of the VDE installations and users. However, certification in Ginter does not notify the electronic property's manufacture in case of property rights violation. At column 128-129, Ginter teaches a Secure Processing Unit (SPU) that maintains an audit trail in a reprogrammable non-volatile memory within the SPU and/or in secure database. The audit trail may consist of a security summary of SPU use. When a request is made to the SPU, it logs the request as having occurred and then notes whether the request succeeded or failed. Failure information, which includes an object ID, a User ID, the type of failure and the time of failure is saved and analyzed to detect cracking attempts or to determine patterns of usage outside expected norms. One of the basic structures, the event summary structure, for which summary service is used is VDE administrator specific and keeps track of events. The event summary structure may be maintained and audited during period contact with VDE administrators. Thus, Ginter teaches a basic structure for auditing usage of the content. VDE administrators may register with the event summary structure to track failures and events. Ginter does not teach that the event summary structure notifies the electronic property's manufacturer in case of property rights violations. Ginter only saves the failure information for analysis by the VDE administrators. Ginter does not notify the manufacturer of the property.

With regard to dependent claim 4, which is representative of claims 20 and 34 with regard to similarly recited subject matter, Ginter does not teach that if ownership of the electronic property is transferred from the current owner to a subsequent owner, appending an entry with information about the subsequent owner in the second field, wherein the information about the subsequent owner includes a time period of ownership for the subsequent owner. The Office Action alleges that Ginter teaches these features at column 26 and associated figures.

At column 26, Ginter teaches that control information components contribute independently to secure communication between each control information influencing VDE participant's VDE installations and may require certification for use with a given application, where such certification was provided by a certification service manager for the VDE arrangement who ensures secure interoperability and/or reliability between appliances and submitted control methods. However, Ginter does not mention anything about appending an entry in the second field associated with the electronic property with

information about the subsequent owner that includes a time period of ownership for the subsequent owner.

To the contrary, at column 214, Ginter teaches the use of a "time aged" key to encrypt or decrypt a set of information for a limited period of time, thus requiring re-registration or the receipt of new permissions or the passing of audit information, without which new keys are not provided for a user use. "Time aged" keys allows content creators/providers to impose a limitation (e.g., site based and/or time based) on information access that is "external of" or auxiliary to the permission provided by one or more permission records. Thus, Ginter teaches using a "time-aged" key to encrypt or decrypt the electronic property for a limited period of time, in order to prevent access to the information after a time period has expired.

In addition, at columns 227-228, Ginter teaches that transfer of a VDE object is a special case in which all of permissions and/or budgets for a VDE object are redistributed to a different protected processing environment (PPE). Some VDE objects may require that all object-related information be delivered (e.g. it is possible to sell all rights to the object). Therefore, Ginter teaches that all permissions, including the time-aged key that defines a time period of access, are transferred to the new VDE object if the ownership of the VDE object is transferred. Ginter does not teach appending an entry, to a second field associated with the electronic property, with information about the subsequent owner that includes a time period of ownership for the subsequent owner, if ownership of the electronic property is transferred from one VDE owner to another.

With regard to dependent claim 5, which is representative of claim 21 with regard to similarly recited subject matter, Ginter does not teach allowing access to the electronic property by the subsequent owner only after the current owner has electronically signed an entry identifying the subsequent owner. The Office Action alleges that Ginter teaches these features at columns 19, 21 and 22. At these columns, Ginter teaches a VDE content container that is used to define the general nature of the VDE capabilities that will and/or may apply to certain electronic information. A VDE content container is an object that contains both content and certain control information related to the use of the object's content. A creating party may make the VDE container available to other parties. The VDE of Ginter also sufficiently impedes unauthorized and/or uncompensated use of

electronic information and/or appliances through the use of secure communications, storage and transaction management technologies. The VDE also supports security architecture for transaction control, auditing, reporting, related communications and information storage.

However, as described above, when ownership of a VDE object is transferred, all permissions and/or budgets are redistributed to a different VDE. In addition, Ginter teaches, at column 228, that if some VDE objects prohibits the transfer of ownership, the original provider for a VDE object may need to be contacted by the new owner, informed of the transfer, and validated using an authorization shared secrets that accompanies reauthorization, before transfer of ownership can be completed. Thus, Ginter teaches an authorization of shared secrets between the current owner and the subsequent owner as a way to complete an ownership transfer. This is contrary to the presently claimed invention, by which access to an electronic property is allowed only after the current owner electronically signs an entry identifying the subsequent owner. Therefore, Ginter does not teach the features of claim 5.

With regard to claim 7, which is representative of claim 23 with regard to similarly recited subject matter, Ginter does not teach sending notice of the transfer of ownership to the electronic property's manufacturer. The Office Action alleges that Ginter teaches these features at columns 286-289. However, Ginter only teaches at these columns that a provider may add control information that enables and/or limits the addition, modification, hiding and/or deletion of said content.

At column 286, lines 10-33, Ginter teaches that the control information includes nature and/or location of content that may be added, hidden, modified and/or deleted; portions of content that may modified, hidden, deleted and/or added to; required secure control information over subsequent VDE container content usage in a chain of control and/or locally to added, hidden, and/or modified content; requirements that provider-specified notices and/or portions of content accompany added, hidden, deleted and/or modified content and/or the fact that said adding, hiding, modification and/or deletion occurred; secure management of limitations and/or requirements concerning content that may be removed, hidden and/or deleted from content, including the amount and/or degree of addition, hiding, modification and/or deletion of content; providing notice to a

provider or providers that modification, hiding, addition and/or deletion has occurred and/or the nature of said occurrence; and other control information concerned with modification, addition and/or deleting provider content (emphasis added).

Thus, Ginter only teaches that notices are provided to the provider when the content is modified, hidden, added or deleted and/or nature of these occurrences. Ginter does not teach sending notice to the electronic property's manufacturer of the transfer of ownership, as recited in claim 7. To the contrary, at column 227, Ginter teaches an electronic appliance authorized to redistribute an object may create an administrative object containing a budget or rights less than or equal to the budget or rights that it owns. Some administrative objects may be sent to other PPEs. Thus, Ginter teaches that the current owner directly notifies administrative objects, which includes budgets or rights of the VDE object, to the subsequent owner. The VDE of Ginter does not notify the current owner or manufacturer of the electronic property of a transfer of ownership.

With regard to dependent claim 9, which is representative of claims 25 and 35 with regard to similarly recited subject matter, Ginter does not teach associating a third field with the electronic property that designates the duration of the time period of the loan. The Office Action alleges that Ginter teaches these features at columns 55-59. At these columns, Ginter teaches "rules and controls" (control information) that define the respective rights and obligations of each of the various VDE participants. "Rules and controls" may specify which financial clearing house may process payments, which participant(s) receive what kind of usage report, and that certain information is revealed to certain participants and that other information is kept secret from them. However, none of the "rules and control" that Ginter teaches designates duration of time period of a loan. As described above, Ginter uses a "time-aged" key to encrypt or decrypt the content in order to prevent access of content after a time period has expired and that when a transfer of ownership occurs, the current owner redistributes all rights, including the "time-aged" key, to the subsequent owner. Thus, Ginter packages all rights or budgets of a current owner and sends them directly to the subsequent owner. Ginter does not associate a third field with the electronic property that designates the duration of the time period of the loan.

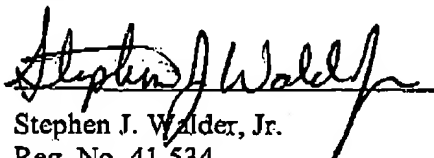
In view of the above, Applicants respectfully submit that Ginter does not teach the specific features of claims 2-16, 18-32 and 34-35 in addition to the features of their respective independent claims. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 2-16, 18-32 and 34-35 under 35 U.S.C. § 102(b).

III. Conclusion

It is respectfully urged that the subject application is patentable over Ginter and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: March 23, 2004



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